

typographical inexactitudes have been rectified to provide better form. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Jaffe. At page 3 of the Office Action, the Examiner admits that Jaffe does not disclose accessing the second bonus game directly from the primary game. In the rejection of claims 1 and 4 with respect to Jaffe, the Examiner merely states that “it would be obvious . . . to provide a function call which activates the second bonus game of Jaffe when the primary outcome primary game has a particular outcome that triggers the second bonus game”. No reference is provided for this assertion, and the only motivation given for combination with Jaffe is “to provide the player more chances to play a variety of bonus games from the outcome of the primary game”.

With regard to rejections under 35 U.S.C. § 103, undersigned provides the following guidance from the Court of Appeals for the Federal Circuit:

“The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783-84 (Fed. Cir. 1992).

“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.” *Interconnect Planning Corp. v. Feil*, 774 F.2d at 1143, 227 U.S.P.Q. at 551. Citing *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 & n. 14, 221 U.S.P.Q. 929, 933 & n. 14 (Fed. Cir. 1984).

“Something in the prior art as a whole must suggest the desirability and thus the obviousness of making the combination.” *Lindemann Mashcinenfabrick GmbH v. American Hoist and Derrick Co.*, 780 F.2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

These are binding precedents with respect to the manner in which patents showing the prior art can be combined. When relying on these principles, it is apparent that the prior art cannot be combined as the Examiner has proposed because there is no teaching suggesting such a combination.

Certainly, only upon reading applicant’s disclosure regarding the triggering of bonus games, the feasibility of introducing a second bonus game that may be triggered from either a primary game or from a first bonus game is evident. It is evident nowhere else. The teachings of Jaffe, as acknowledged in applicant’s Amendment of January 98, 2002, are detailed. Jaffe explicitly includes a second bonus that is triggered merely and only by the first bonus, but nowhere does he entertain the possibility of triggering the second bonus from the primary game. Such a detailed disclosure would have revealed the possibility, had it been contemplated.

As for the motivation to support an obviousness rejection, the abovementioned citations compel its presence in the prior art, rather than its appearance as the product of hindsight upon reading applicant’s disclosure.

With reference to the Office Action of October 15, 2001, undersigned notes the Examiner’s statements with regard to the prior art. Claims 1 and 4 have been further amended, and new claims 8 and 9 have been added, in an attempt to comport with the Examiner’s perception of patentability when considering the gist of claim 2.

It is believed that the foregoing revisions to the claims are within the metes and bounds of the recently articulated Supreme Court *Festo* case, in that all equivalents

susceptible to capture have been retained in that one skilled in the art, at the time of this amendment, could not have reasonably be expected to have drafted a claim that would have literally encompassed any other equivalent.

The Examiner is respectfully requested to note that the Office Action to which this amendment responds was mailed on April 4, 2002, thereby requiring a response on August 4, 2002. August 4, 2002 was a Sunday. Therefore this amendment is timely filed on Monday, August 5, 2002.

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

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Bracketed and Underlined Claims

Claim 1 (amended) - A gaming device, comprising, in combination:
wager accepting means,
a display,
processor means for operating said display as a function of a player
activating said wager accepting means by placing a wager,
a primary game on said display having a first and a second particular
outcome[s] thereon, and
first and second bonus games, [both of] said first bonus game[s are] is
accessed via said first particular outcome[s] on said primary game, and said second
bonus game is accessed by said second particular outcome, and said first bonus game
also includes [means] an outcome to play said second bonus game.

Claim 4 (amended) - A gaming method, the steps including:
accepting a wager,
displaying a primary game,
providing a first bonus game outcome which leads to a first bonus game
embodied as a pathway,
providing a first bonus game outcome which leads to a second bonus
game embodied as a pathway and
providing a primary game second outcome which leads to said second
bonus game and bypasses completely said first bonus game.